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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,766	07/18/2000	Matthew W. Milne	K35A0625	8824

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EXAMINER

NGUYEN, DUSTIN

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/618,766	Applicant(s) MILNE ET AL.	
	Examiner Dustin Nguyen	Art Unit 2154	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>07/30/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 17 are presented for consideration.

Response to Arguments

2. Applicant's arguments filed 06/07/2004 have been fully considered but they are not persuasive.

3. As per remarks, Applicants' argued that the cited references fail to teach or suggest in isolation or in combination at least one limitation from each of independent claims 1 and 10, specifically, the BCL in Hubacher reference is not executed in the disk drive.

4. As to the above point, the limitation is rejected as mentioned previous Office Action mailed 02/04/2004. Furthermore, Hubacher discloses the disk drive executable code in the disk drive [i.e. to load a BCL from a nonvolatile, read/write memory, such as diskette or hard disk] [col 2, lines 49-51].

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-3, 5, 10, 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601].

7. As per claim 1, Klimenko discloses the invention substantially as claimed including a method of delivering content from a content delivery server to a personal computer system that includes a computing subsystem and a disk drive, the method comprising:

selecting a network address for the content delivery server [col 10, lines 57-col 11, lines 7];

selecting a server-contacting program [col 7, lines 62-col 8, lines 6];

configuring the content delivery server [col 11, lines 34-49], the configuring comprising:

receiving user information from the personal computer system while the personal computer system is connected to the content delivery server [col 11, lines 50-65]; and

delivering content to the personal computer system in response to the user information [col 11, lines 66-col 12, lines 31].

Klimenko does not specifically disclose

storing the network address and the server-contact program in the disk drive;

installing disk drive executable code in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal

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computer system, wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server.

Hubacher discloses

storing the network address and the server-contact program in the disk drive [col 6, lines 22-col 7, lines 21];

installing disk drive executable code in the disk drive to initiate execution of the server-contacting program after the disk drive is connected to the computing subsystem in the personal computer system, wherein execution of the server-contact program includes using the network address for connecting the personal computer system to the content delivery server [col 2, lines 46-67].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko and Hubacher because Hubacher's teaching would provide a more efficient method for distributing content to multiple users.

8. As per claim 2, Klimenko does not specifically disclose a protected area; and the network address and the server-contacting program are stored in the protected area. Hubacher discloses a protected area; and the network address and the server-contacting program are stored in the protected area [col 6, lines 1-16]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko and Hubacher because Hubacher's teaching of protected are would allow to protect files to prevent system corruption.

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9. As per claim 3, Klimenko discloses the firmware resides in the disk controller circuit [334, Figure 3].

10. As per claim 5, Klimenko discloses the personal computer system displays the content during a boot sequence [col 3, lines 10-13].

11. As per claim 10, it is apparatus claimed of claim 1, it is rejected for similar reasons as stated above in claim 1. Furthermore, Klimenko discloses a database including the user information associated with the disk drive in the personal computer system [Figure 2B; and].

12. As per claim 11, Klimenko discloses the disk controller circuit automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system [col 12, lines 56-65].

13. As per claim 15, it is apparatus claimed of claim 5, it is rejected for similar reason as stated above in claim 5.

14. Claims 4, 7-9, 12-14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601], and further in view of Welder [US Patent No 6,473,855].

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15. As per claim 4, Klimenko and Hubacher do not specifically disclose the disk drive executable code delays initiating execution of the server-contacting program until a predetermined period has lapsed. Welder discloses the disk drive executable code delays initiating execution of the server-contacting program until a predetermined period has lapsed [Figure 4A]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko, Hubacher and Welder because Welder's teaching would provide additional option for user to interrupt the process for other tasks or purposes.

16. As per claim 7, Klimenko and Hubacher do not specifically disclose the disk drive executable code delays initiating execution of the server-contacting program until the disk drive executable code determines that a selected number of monitored events exceeds a threshold. Welder discloses the disk drive executable code delays initiating execution of the server-contacting program until the disk drive executable code determines that a selected number of monitored events exceeds a threshold [col 11, lines 20-46]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Klimenko, Hubacher and Welder because Welder's teaching would allow to monitor the workload to increase system performance.

17. As per claim 8, Welder discloses the monitored events includes the number of boot-ups in the computing subsystem [col 2, lines 26-31].

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18. As per claim 9, Welder discloses the content is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data [col 2, lines 51-55].

19. As per claim 12, it is apparatus claimed of claim 4, it is rejected for similar reasons as stated above in claim 4.

20. As per claims 13 and 14, they are apparatus claimed of claims 7 and 8, they are rejected for similar reasons as stated above in claims 7 and 8.

21. As per claim 17, it is apparatus claimed of claim 9, it is rejected for similar reason as stated above in claim 9.

22. Claims 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klimenko [US Patent No 5,974,547], in view of Hubacher et al. [US Patent No 6,487,601], and further in view of Peterson et al. [US Patent No 6,594,682].

23. As per claim 6, Klimenko and Hubacher do not specifically disclose the content is periodically changed according to a presentation schedule. Peterson discloses the content is periodically changed according to a presentation schedule [col 6, lines 38-52]. It would have been obvious to a person skill in the art at the time at the time the invention was made to

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combine the teaching of Klimenko, Hubacher and Peterson because Peterson's teaching of changing content would allow content to be updated more often to fit customer's need and provide more valuable information.

24. As per claim 16, it is apparatus claimed of claim 6, it is rejected for similar reasons as stated above in claim 6.

25. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on flex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Follansbee John can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dustin Nguyen
Examiner
Art Unit 2154



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
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